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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,517

09/11/2003

Mamoud Sadre

3614

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03/24/2011

EXAMINER

ROBERTSON, DAVID

ART UNIT

PAPER NUMBER

2121

MAIL DATE

DELIVERY MODE

03/24/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,517	Applicant(s) SADRE, MAMOUD	
	Examiner Dave Robertson	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Non-final office action in response to the Supplemental Amendment received December 3, 2010.

Examiner invites Applicant to request an interview with the Examiner upon receipt or in due course *prior to* response to this office action as allowable subject matter may be present in the application and thus allowable if properly and fully claimed, and further to ensure a full and complete response to issued raised herein.

Pro Se Applicant/Inventor

2. An examination of this application and application history reveals that applicant is not fully familiar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution.

The Office cannot aid in selecting an attorney or agent. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

Response to Amendment

3. The Supplemental Amendment was requested by the Examiner to advance prosecution in lieu of further delay by Notice of Non-compliance as the claims filed 9/27/2010 did not properly show what was added and deleted from the claims from the then current status (as of 3/19/2010). However, in the Amendment of 12/3/2010, as in the previous Amendment of 11/30/2010, claims 11-15 were omitted in the mailing and fax transmission, and were not indicated as being cancelled.

Applicant is requested to be sure to file a complete set of claims properly showing all claim amendments in all future amendments.

Examiner also notes that the "Proposed revised claim" in Remarks filed 12/01/2010 and 12/4/2010 is not a proper Amendment to claims and that these claims are not entered or considered herein.

Response to Arguments

4. Applicant's Amendments and Remarks thereto (filed 9/27/2010, 12/01/2010, and 12/4/2010), do not fully or substantively address all rejections made by the Examiner in the office action of 7/9/2010, namely the rejections made under 35 U.S.C. 112.

With regard to 35 U.S.C. 112, 2nd paragraph (OA of 7/8/2010, pg. 5), the rejection was based on the preamble claiming two statutory types of invention, a *system* and a *procedure*. Amendment to the preamble deletes only *methodology*, and therefore now claims both a *system* (a machine) and a *procedure* (presumed to be a method).

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Further with regard to 35 U.S.C. 112, 2nd paragraph (OA of 7/8/2010, pg. 6), the rejection was based on indefiniteness arising from 35 U.S.C. 112, 6th paragraph, namely, the use of *means for* language in the claims. As explained below, invoking 35 U.S.C. 112, 6th paragraph, by the use of *means for* language carries special requirements as to clarity and disclosure of the means and equivalents to which functions are recited. It is not clear from Applicant's response how or where the rejection is addressed.

Notwithstanding the above, and because the invention as claimed is indefinite with respect to 35 U.S.C. 112, 2nd paragraph (as below), and because such indefiniteness as to the metes and bounds of the claims preclude examination on the merits and as well to determining adequacy and enablement of the written description, the rejections of the prior office action are presently withdrawn.

Priority

5. This application is claiming the benefit of prior-filed non-provisional application No. 09/640,272 under 35 U.S.C. 121 (CIP). However, copendency between the current application and the prior application was required at the time of filing.

A careful review of the application file of 09/640,272 indicates that this application was officially abandoned as of its three-month statutory period of reply (6/16/2003), not the date of mailing of the Notice of Abandonment (10/16/2003). Therefore, the prior-filed application was not co-pending as of the present applications filing date of 9/11/2003. Since the applications are not copending, the benefit claim to the prior-filed

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non-provisional application is improper and benefit cannot be granted under 35 U.S.C. 121.

Applicant is required to delete the reference to the prior-filed application from the Utility Patent Application Transmittal (or supply a new Application Data Sheet or other indication) unless applicant can establish copendency between the applications.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites: **A data processing system and procedure that extracts..., containing...means for building...; means for generating...; means for developing...; means for compiling...; and means for storing, comparing, unifying, and updating...** However, it is unclear what statutory class of invention is being claimed and therefore indefinite as to the scope of the claims presented for examination. Claims 2-15 depend from claim 1 and are similarly deficient as follows:

A *system* is a machine or apparatus, while a *procedure* is a series of steps of acts in the performing of a process. Because Applicant has not claimed any particular structure for a system, or any series of acts of a procedure or process, it cannot be

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determined which statutory class Applicant is claiming as the invention and therefore the claims are indefinite.

8. Claims 1-15 are further rejected under 35 USC § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites: **A system methodology and procedure that extracts..., containing...means for building...; means for generating...; means for developing...; means for compiling...; and means for storing, comparing, unifying, and updating...**

The limitations invoke 35 USC § 112, 6th paragraph, because each limitations meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.”

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In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. Aristocrat Technologies, Inc. v. International Game Technology, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. Aristocrat, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function, however, in conjunction with the indefiniteness detailed above under 35 U.S.C. 112, 2nd paragraph, it is not apparent what *means* are proscribed by the *data processing system* and *procedure...* as recited, as there is no structure recited in the specification for the performing each functional *means* as required under 35 USC § 112, 6th paragraph.

Applicant is requested on response to indicate what portions of the specification and drawings disclose sufficient corresponding structure, material or acts for performing the claimed function of each limitation.

Because it cannot be precisely determined what statutory class of invention is being claimed, and because the present status of claims lacks formal filing of amendments to claims 11-15, examination on the merits at this time is precluded.

Conclusion

9. Applicant is further apprised of the prior art made of record previously cited or newly listed on the attached PTO Form 892. The cited prior art is not presently relied upon but is considered pertinent to applicant's disclosure and may be relied upon as prior art in a future office action. In particular:

Heaton et al. (US Pat. No. 7,729,949, 2010/0042531) teaches a system and method of offering a futures contract on diamonds based on standardized profiles of diamonds indexed to a standard commodity index.

Huang et al. (US Pat. 5,953,707) teaches a Decision Support System, including using Pareto Analysis (see Figure 29 and column 40) for determination of classifications of products by a system of aggregate production planning and market data analysis (Figure 28 and columns 38-39).

McClendon et al. (US Pat. No. 6,625,619) teaches a method and system for creating an electronic taxonomy for construction products based on a hierarchical structure including capturing market-based cost information.

Sankaran et al. (US. Pat. No. 7,516,084) teaches building a hierarchical taxonomy of a product family successively subdivided into its constituent products.

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Shepherd (US Pat. No. 6,134,536) teaches a system and method building a hierarchy of categories of a product based on *value-added* components.

Noori et al. (2000) is provided as background in the art of Fractal Manufacturing.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on Weekdays 8:15 am to 4:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Robertson/
Examiner, Art Unit 2121